

**III. REMARKS**

In the Office Action (Point 1), the examiner stated that, in the previous response, insufficient evidence was submitted with the declaration submitted under 37 C.F.R. 1.131 to establish diligence from a date prior to the date of reduction to practice of Enoki (US 5,835,853) and to overcome the rejections under Enoki. In a telephone conversation with the examiner on May 22, 2006, it was determined that a copy of the British application, as it existed a few days before the British filing, and authenticated by the inventor or attorney who handled it, would provide the necessary showing of the earlier existence of the description of the same invention plus the diligence to the filing date. In a subsequent telephone conversation, the examiner stated that the priority British application had already been received, but that the signature and the date of signing were not shown. The examiner stated further that the signature and date would be received and considered after the Final Rejection.

On pages 3-7 of the Office Action, claims 26-50 and 58-61 were rejected under 35 U.S.C. 102(e) as being anticipated by Enoki, claims 56-57 were rejected under 35 U.S.C. 103 as being unpatentable over Enoki, and claims 51-55 were rejected under 35 U.S.C. 103 as being unpatentable over Enoki in view of Ramesh (US 5,943,324) for reasons et forth in the Action. These same references served as the grounds of rejection in the previous Office Action.

The primary reference is Enoki which is employed in the rejection of all of the claims, most of the claims being rejected on the teachings of Enoki alone, while claims 51-55 are rejected on the teachings of Enoki in combination with Ramesh.

In order to overcome the Enoki reference, a Supplemental Declaration under 37 C.F.R. 1.131 is being submitted to show a date of invention of the present invention which is prior to the US filing date of the Enoki reference. The Supplemental Declaration is accompanied by evidence identified as Exhibit "A", namely, a copy of the British priority

application for patent including signed papers with a date of signature of December 20, 1996 (this being a Friday). This signature date is three days earlier than the British filing date of December 23, 1996 (this being the following Monday).

This evidence is believed to be the necessary showing (required by the examiner) of the earlier existence of the description of the present invention plus diligence to the filing date, so as to overcome the foregoing rejections based on Enoki and to obtain allowance of the claims.

As was stated in the previous response, the present application 09/902,193 was filed on July 10, 2001 as a division of parent application 08/994,228 which has a US filing date of December 19, 1997, and which claims right of priority in the aforementioned patent application filed previously in Great Britain on December 23, 1996 with application number 9626732.3. Therefore, the present application has right of priority in the parent application and, via the parent application, right of priority in the British application.

The Enoki reference issued as US patent 5,835,853 on November 10, 1998, which date is after the filing date of the parent application. The Enoki US filing date is December 20, 1996, which date is prior to the US filing date of the parent application. Accordingly, Enoki is available as a reference under 35 U.S.C. 102(e)/103 with the effective date of December 20, 1996, the Enoki US filing date. However, in view of this supplemental declaration, it is clear that the effective date of Enoki is not prior to the execution date December 20, 1996 of the British application.

Great Britain is a WTO country, and 35 U.S.C. 104 permits activity in a WTO country to be used to establish a date of invention, thereby to show conception and diligence relating to the present invention prior to the effective date of the Enoki reference. The filing of a patent application is considered as a constructive reduction to practice of the invention. Herein, there is the filing of the patent application in Great Britain followed

by a filing of the parent patent application in the United States, the latter filing being within the convention year, and claiming priority in the British application.

Accordingly, there is need to show conception and diligence only during a critical period of three days, namely, from a point in time prior to the Enoki filing date of December 20, 1996 until the filing date in Great Britain of December 23, 1996.

The enclosed Supplemental Declaration under 37 C.F.R. 1.131 is executed by the inventor, John A. Samuels, named in the present application. The declaration states that a description of the present invention, as set forth in the claims of the present application, is present in the text and figures of the British application, and was present from a time prior to the Enoki filing date. It is urged that this proves conception at a point in time prior to the Enoki filing date.

Further, the declaration states that James Seymour, who works in the Intellectual Property Rights department of Nokia in Great Britain, attended to the performance of tasks relating to the filing of the British application, and that these tasks were performed during the period extending from a time prior to December 20, 1996 until December 23, 1996. As is well known, such tasks involve the preparation of documents to be signed by the inventors, and activity relating to obtaining the signatures of the inventors. It is urged that this proves diligence from a point in time prior to the Enoki filing date until the filing of the British patent application.

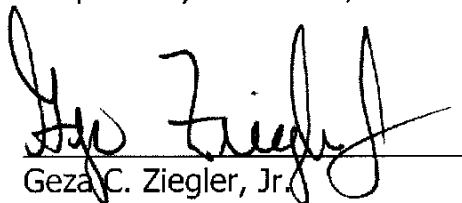
Therefore, based on the material in the British patent application describing the present invention, and based on the dates and time frame of activity in Great Britain established in the declaration, it is concluded that conception of the invention claimed in the present application occurred prior to the Enoki filing date, and that the conception has been followed by diligence until the constructive reduction to practice of the invention in the filings of the British and United States patent applications.

The foregoing argument in conjunction with the declaration and its attached Exhibit "A" are believed to overcome the rejections under 35 U.S.C. 103 so as to secure allowance of the claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
Geza C. Ziegler, Jr.  
Reg. No. 44,004

18 Dec 2006  
Date

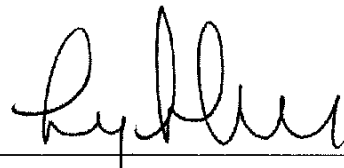
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### **CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 18 December 2006

Signature: \_\_\_\_\_



Lisa Shimizu

Person Making Deposit